# UNITED STATES PATENT AND TRADEMARK OFFICE

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| 09/658,332 | 09/08/2000 | Teddy A. Demirjian | WIZZ.002DV1 | 2582 |

| 20995 | 7590 | 04/06/2005 | EXAMINER |
|---|---|---|---|

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| | COLBERT, ELLA |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3624 | |

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | Application No. | Applicant(s) |
|---|---|---|
| **Office Action Summary** | 09/658,332 | DEMIRJIAN, TEDDY A. |
| | **Examiner** | **Art Unit** | |
| | Ella Colbert | 3624 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on <u>24 January 2005</u>.

2a)☐ This action is **FINAL**.     2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) <u>6,8 and 9</u> is/are pending in the application.

    4a) Of the above claim(s) <u>10</u> is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>6,8 and 9</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____ .

## DETAILED ACTION

1.      Claims 6 and 8-10 are pending. Claim 6 has been amended and claim 10 has

been added in this communication filed 1/24/05 entered as RCE and Amendment.

2.      The 35 USC 112 Second paragraph rejection in the office action of 9/14/04 is

herein withdrawn in view of a new 35 USC 112 second paragraph rejection of claim 6 as

set forth here below.

### *Continued Examination Under 37 CFR 1.114*

3.      A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/24/05

has been entered.

### *Restriction by Original Presentation*

4.      Newly submitted claim 10 is directed to an invention that is independent or

distinct from the invention originally claimed for the following reasons: Claim 10 has the

following features that are not found in claims 6, 8, and 9; different users managing an

entire life cycle of a equity order transaction; assistant portfolio managers, compliance

officers, custodian banks, and electronic trading venues; valid dialog/presentation

information combinations that are available to the system user based on the user's role;

valid business logic information combinations available to a system user based on the

user's role and investment advisor site definitions of business access authorization;

valid user/investment advisor site information for valid configurations for user roles and

site configuration; business logic information; presentation dialog manager storing

various screens that are available to authorized users; a user plug-in module that

manages how data is formatted when either sent or received; an information manager

that manages the connections with 3$^{rd}$ party data vendors; a security module that

authenticates the user session to allow the authorized user access to the system; and a

network connection module that interfaces with the security module allow network traffic

in and out of the network and managing network connections.

Since applicant has received an action on the merits for the originally presented

invention, this invention has been constructively elected by original presentation for

prosecution on the merits. Accordingly, claim 10 is withdrawn from consideration as

being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP 821.03.

Also see Response to Arguments section below.

### Claim Objections

5.      5.      Claim 6 objected to because of the following informalities:  Claim 6, lines 3-19

recites "at least one server coupled to a investment advisor computer network

comprising ...; manipulation logic and data display format and a plurality of business

logic rules defining ... users, said at least one database also having stored thereon

client transaction information ...; ...; a transaction manager configured to (1) receive

transaction requests from said user ... (2) forward transactions that the user is

authorized to perform to transaction execution modules, wherein said forwarding ...".

These lines would be better recited as "at least one server coupled to an investment

advisor computer network comprising ...; manipulation logic, data display format and a

plurality of business logic rules defining ... users, said at least one database having

stored thereon client transaction information ...; ...; a transaction manager configured to

(1) receive transaction requests from said user ... (2) forward transactions that the user

is authorized to perform to transaction execution modules, wherein said forwarding ...".

Appropriate correction is required.

### Specification

6.      The disclosure is objected to because of the following informalities: Page 10, line

8 recites "with broker &/or custodian ...". This line should read "with broker and/or

custodian ...". Page 5, line 21 recites "trade. DTC eligible trades ...". It is not

understood what the acronym "DTC" stands for in the Specification. This line should be

written as "Dealer Trade Connection (DTC) eligible trades ...". Page 6, line 10 recites

"..., (2) by a "cut & paste" approach in which". This line should be written as "..., (2) by

a "cut and paste" approach in which". Page 13 lines 16-18 recite "... user requests as

the 1st request ... and Presentation/Dialog manager 940. The system has taken 12 core

process ...". These lines should be written as "... user requests as the first request ...

and Presentation/Dialog manager 940. The system has taken twelve (12) core

processes ...". Page 14, line 30 and page 18, line 29 has a similar problem. Page 14,

lines 14-17 recites "an executable file and a DLL ... locally. This will allow ...

investment advisor PC. The DLL is a ". These lines should have the acronyms written

as Dynamic Link Library (DLL) and Personal Computer (PC). Page 15, line 30 recites

"... and/or hardware. Th Plug-In Module 928". This line should read "... and/or

hardware. The Plug-In Module 928". Page 17, line 28 needs a period (.) after "levels".

Applicant is respectfully requested to check for other spelling and grammatical errors in

the Specification since these are only a few of the errors found.

A substitute specification in proper idiomatic English and in compliance with 37

CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied

by a statement that it contains no new matter. Appropriate correction is required.

### *Drawings*

7.      New corrected drawings in compliance with 37 CFR 1.121(d) are required in this

application because Figure 3 does not have the element "306" labeled as USER

PROFILES DATABASE, 304 labeled as RULES DATABASE., and 302 labeled as

FINANCIAL INFORMATION DATABASE. The Specification on page 10, line 5 and line

11 reference element "306" as "User Profiles Database", element "304" as "Rules

Database", and element "302" as "Financial Information Database". The Specification

and drawings should be in agreement. Applicant is advised to employ the services of a

competent patent draftsperson outside the Office, as the U.S. Patent and Trademark

Office no longer prepares new drawings. The corrected drawings are required in reply to

the Office action to avoid abandonment of the application. The requirement for

corrected drawings will not be held in abeyance.

### *Claim Rejections - 35 USC § 112*

8.      The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

9.      Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite

for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention.  Claim 6 in paragraph 2 recites "at least one database hosted

by said at least one server having stored thereon a plurality of user profiles which

correlate system users with user specific data manipulation logic and data display

format and a plurality of business logic rules defining system operations that are

performed in response to transactions requested by system users, said at least one

database also having stored thereon client transaction information such that a common

set of client transaction information is available for display and manipulation to the

investment advisor firm as well as broker/dealer firms and custodian banks in

accordance with a user profile defined for each corresponding user; paragraph 4 recites

a transaction manager configured to (1) receive transaction requests from said user

profile and session manager, said transaction requests operative to produce changes to

database content and user display, and also configured to (2) forward transactions that

the user is authorized to perform to transaction execution modules, wherein said

forwarding comprises transmitting a logic execution request for database changes to a

business logic manager configured to execute the transactions that the user is

authorized to perform in accordance with said business logic rules and transmitting a

presentation request to a presentation dialog manager configured to display data to the

screen according to the user profile; and the last paragraph of claim 6 on page 3 recites

"wherein said business logic rules and user profiles are configured such that a portfolio

manager system user inputs equity trades for a plurality of investors to the system using

an interface defined by a user profile assigned to said portfolio manager system user,

and such that a broker/dealer user of the system receives information regarding said

equity trades in a format defined by a user profile assigned to said broker/dealer user of

the system". These claim limitations are very confusing and unclear as written. It

cannot be determined what the Applicant is trying to claim as the invention.

The Examiner is unable to determine the metes and bounds of claim 6 because of the

manner in which the claim limitations are written. Therefore the art is being applied in

light of 35 USC 112, second paragraph.

The Examiner has applied the best art that is considered applicable according to the

broadest reasonable interpretation of the claims.

## Claim Rejections - 35 USC § 103

10.    The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11.    The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

    1.    Determining the scope and contents of the prior art.
    2.    Ascertaining the differences between the prior art and the claims at issue.
    3.    Resolving the level of ordinary skill in the pertinent art.
    4.    Considering objective evidence present in the application indicating obviousness or nonobviousness.

12.     Claims 6, 8, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable

over (US 5,918,217) Maggioncalda et al, hereafter Maggioncalda in view of (US

6,615,258) Barry et al, hereafter Barry.

As per claim 6,  Maggioncalda teaches, An information management system

accessible simultaneously to a plurality of users, said system comprising:  at least one

server coupled to a investment advisor computer network comprising computers used

by portfolio managers and equity traders (col. 5, lines 39-col. 6, line 14 and fig. 1); at

least one database hosted by said at least one server having stored thereon a plurality

of user profiles which correlate system users with user specific data manipulation logic

and data display format and a plurality of business logic rules defining system

operations that are performed in response to transactions requested by system users,

said at least one database also having stored thereon client transaction information

such that a common set of client transaction information is available for display and

manipulation to the investment advisor firm as well as broker/dealer firms and custodian

banks in accordance with a user profile defined for each corresponding user (col. 6,

lines 10-12 and lines 46-54 and line 63-col. 7, line 58, col. 8, lines 57-62, and col. 10,

lines 20-58);   a user profile and session manager configured to process the at least one

user profile to determine which information is available to a user and a data display

format that at least in part defines system operation (col. 5, line 47-col. 6, line 42, fig. 1,

and fig. 2); and wherein said business logic rules and user profiles are configured such

that a portfolio manager system user inputs equity trades for a plurality of investors to

the system using an interface defined by a user profile assigned to said portfolio

manager system user, and such that a broker/dealer user of the system receives

information regarding said equity trades in a format defined by a user profile assigned to

said broker/dealer user of the system. Barry teaches, wherein said business logic rules

and user profiles are configured such that a portfolio manager system user inputs equity

trades for a plurality of investors to the system using an interface defined by a user

profile assigned to said portfolio manager system user, and such that a broker/dealer

user of the system receives information regarding said equity trades in a format defined

by a user profile assigned to said broker/dealer user of the system (col. 6, lines 10-12,

col. 7, lines 8-37, col. 10, lines 20-30 and line 46 –col. 11, line 16, fig. 3, fig. 4, fig. 5b,

fig. 8, and fig. 11).

Maggioncalda failed to teach, a transaction manager configured to (1) receive

transaction requests from said user profile and session manager, said transaction

requests operative to produce changes to database content and user display, and also

configured to (2) forward transactions that the user is authorized to perform to

transaction execution modules, wherein said forwarding comprises transmitting a logic

execution request for database changes to a business logic manager configured to

execute the transactions that the user is authorized to perform in accordance with said

business logic rules and transmitting a presentation request to a presentation dialog

manager configured to display data to the screen according to the user profile; an

information manager configured to store executed transactions in the at least one

database, wherein at least some of the business logic rules define modifications to user

profiles to be performed in response to modifications of client transaction information.

Barry teaches, a transaction manager (fig. 16b (2320)) configured to (1) receive

transaction requests from said user profile (fig. 7) and session manager (col. 6, lines 57-

66), said transaction requests (fig. 16b (2310)) operative to produce changes to

database content and user display (col. 40, lines 45-61), and also configured to (2)

forward transactions that the user is authorized to perform to transaction execution

modules, wherein said forwarding comprises transmitting a logic execution request for

database changes to a business logic rules and transmitting a presentation request to a

presentation dialog manager configured to display data to the screen according to the

user profile (fig. 1 (20), fig. 1 (12), (fig. 5)) and an information manager configured to

store executed transactions in the at least one database, wherein at least some of the

business logic rules define modifications to user profiles to be performed in response to

modifications of client transaction information (col. 20, line 47-col. 21, line 14). It would

have been obvious to one having ordinary skill in the art at the time the invention was

made to have a transaction manager configured to (1) receive transaction requests from

said user profile and session manager, said transaction requests operative to produce

changes to database content and user display, and also configured to (2) forward

transactions that the user is authorized to perform to transaction execution modules,

wherein said forwarding comprises transmitting a logic execution request for database

changes to a business logic manager configured to execute the transactions that the

user is authorized to perform in accordance with said business logic rules and

transmitting a presentation request to a presentation dialog manager configured to

display data to the screen according to the user profile; an information manager

configured to store executed transactions in the at least one database, wherein at least

some of the business logic rules define modifications to user profiles to be performed in

response to modifications of client transaction information and to modify in

Maggioncalda because such a modification would allow Maggioncalda's system to have

the ability to receive transaction requests from a user according to the user profile.

As per claim 8,  Maggioncalda failed to teach, The system of Claim 6, wherein

said server is coupled to said investment advisor network of computers via the Internet.

Barry teaches, said server is coupled to said investment advisor network of computers

via the Internet (col.2, lines 47-49 and fig. 1 (22 and 24). It would have been obvious to

one having ordinary skill in the art at the time the invention was made to have the server

coupled to the investment advisor network of computers via the Internet and to modify in

Maggioncalda because such a modification would allow Maggioncalda to have a more

efficient and economical investor advisor system.

AS per claim 9,  Maggioncalda failed to teach, The system of Claim 8, wherein

said investment advisor computers access said server via a browser application.  Barry

teaches, wherein said investment advisor computers access said server via a browser

application (col. 2, lines 47-65 and fig. 2 (20 & 24). It would have been obvious to one

having ordinary skill in the art at the time the invention was made to have the

investment advisor computers access the server via a browser application and to modify

in Maggioncalda because such a modification would allow Maggioncalda to provide

investment advisory services over the Internet using a server to access the browser

application.

## *Response to Arguments*

13.     Applicant's arguments with respect to claims 6, 8, and 9 have been considered

and a new ground(s) of rejection has been given.

Issue no. 1:  Applicant argues: New claim 10 recites hardware and software

elements for implementing such a system and the Examiners' attention is drawn

specifically to the "user profile information which correlates system users with the

specific data manipulation logic to client accounts and specific data display format that

is presented to the system user" and the "business logic information that defines the

specific data manipulation routines and logic that are permitted against an equity

transaction through out the life cycle of the transaction as defined by authorized user(s)

of the said system" has been considered but is not persuasive.  Response:  Claim 10

has been restricted by Original presentation because claim 10 has limitations that are

not found in claims 6, 8, and 9.  Claim 10 appears to be everything trying to be claimed

in one claim that has not been presented in the other claim limitations of claims 6, 8,

and 9 and is therefore considered a separate invention since this claim can stand alone

in another application or separate invention.  Claim 10 does not need claims 6, 8, and 9

and because these inventions are distinct for the reasons given above and have

acquired a separate status in the art, restriction for examination purposes as indicated is

proper.  It is suggested: Either claim 10 be more closely related to claim 6 and to add

the life cycle element to claims 6 and 10 if that is what the Applicant is claiming.

The In response to applicant's arguments, the recitation "entire life cycle of an

equity order transaction" has not been given patentable weight because the recitation

occurs in the preamble. A preamble is generally not accorded any patentable weight

where it merely recites the purpose of a process or the intended use of a structure, and

where the body of the claim does not depend on the preamble for completeness but,

instead, the process steps or structural limitations are able to stand alone. See *In re*

*Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150,

152, 88 USPQ 478, 481 (CCPA 1951).

In response to Applicant's argument that claim 10 shows certain features of

applicant's invention as claimed in claim 6, it is noted that the features upon which

applicant relies (i.e., "user profile information which correlates system users with the

specific data manipulation logic to client accounts and specific data display format that

is presented to the system user" and the "business logic information that defines the

specific data manipulation routines and logic that are permitted against an equity

transaction through out the life cycle of the transaction as defined by authorized user(s)

of the said system") are not recited in claim 10.

Conclusion: Applicant is respectfully requested to view the claims in the

references used in this rejection for the preferred format of the independent claims

rejected under 35 USC 112 second paragraph.

### Conclusion

14.    The prior art made of record and not relied upon is considered pertinent to

Applicant's disclosure.

Brumbelow et al (US 6,119,104) disclosed a multi-desktop computer system for a

bank or other financial institution and brokerage desktops.

Hambrecht et al (US 6,629,082) disclosed equity securities and a communication

network.

## Inquiries

15.     Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Ella Colbert whose telephone number is 703-308-7064.

The examiner can normally be reached on Monday-Thursday, 6:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Vincent Millin can be reached on 703-308-1038.  The fax phone number for

the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system.  Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

E. Colbert
April 2, 2005